data provided in the previous Amendment and Response dated October 12, 1998, in the form of a Declaration.

Claims 29-68 are pending in this application. Claims 52-68 have been withdrawn by the Examiner as allegedly being independent or distinct from the invention originally claimed.

It is noted with appreciation that the Examiner has withdrawn the rejection of Claims 30, 37-39, 46-48 and 51 under 35 U.S.C. § 112, second paragraph.

Withdrawal of Claims 52-68

It is respectfully requested that the withdrawal of Claims 52-68 be reconsidered. It is submitted that a thorough search for the subject matter of Claims 29-51 should also include the subject matter of Claims 52-68. All of the claims relate to a method and the product produced by that method. Where a single field of search thoroughly covers all of the claims in an application, different classifications in the Patent and Trademark Office should not be controlling. As noted in the Commissioner's Notice of April 9, 1975, 930 OG 450, and reiterated at M.P.E.P. § 803, if a search and examination of an entire application can be made without serious burden, the Examiner must examine the application on the merits, even though it includes claims to two distinct or independent inventions. In the present case, Claims 29-51 and Claims 52-68 are so closely related as to be capable of examination together. The Examiner's withdrawal of Claims 52-68 in this case

only serves to increase the prosecution expense to the Applicant and to the Patent and Trademark Office. Therefore, it is respectfully requested that the withdrawal of Claims 52-68 be withdrawn.

References cited in the Information Disclosure Statement

The Examiner has indicated that not all of the references cited in the Information Disclosure Statement were received in the present application. It is respectfully noted that the present application is a divisional of U.S. Application Serial No. 08/483,477, filed June 7, 1995, which issued as U.S. Patent No. 5,698,244 on December 16, 1997. As such, the references cited in the Information Disclosure Statement are of record. However, in order to expedite the prosecution of the present application, copies of references which are not initialed on the PTO form 1449 are enclosed herewith, except U.S. Patent items AE through AL a copy of which will be submitted shortly.

Rejection under 35 U.S.C. § 102(b)

Claims 29-51 are rejected as allegedly being anticipated by Ise or Hagemeister *et al*. Reconsideration of this rejection is respectfully requested as the composition of the milk product of the present invention is different than the composition of milk produced by cows fed fish oils.

As the enclosed Declaration by Dr. William R. Barclay shows, the fatty acid composition of the milk product of the present

invention contains a different amount of a variety of fatty acids than the milk produced by cows fed fish oils. Therefore, since the milk product composition of the present invention is different than the milk composition of cows fed fish oils, rejection of Claims 29-51 under 35 U.S.C. 102(b) is improper. Thus, it is respectfully requested that this rejection be withdrawn.

Rejection under 35 U.S.C. §103(a)

Claims 29-50 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over either one of the Hagemeister abstract or the Ise patent taken together with the Long reference. Reconsideration of this rejection is respectfully requested as the combination of the teaching of the Hagemeister abstract or the Ise patent with the teaching of the Long reference is improper because there is no suggestion whatsoever for making the combination.

Claims cannot be found obvious in view of a combination of references unless the prior art itself suggests the desirability of the combination. *Berghauser v. Dann*, 204 U.S.P.Q. 393 (D.D.C. 1979); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929 (Fed. Cir. 1984). There must be something in the prior art that would have motivated persons of ordinary skill to make the combination. *In re Stencel*, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987), *accord*, *Ex parte Marinaccio*, 10 U.S.P.Q.2d 1716 (Pat. Off. Bd. App. 1989) (combining references is improper absent some teaching, suggestion, or motivation for the combination in the

prior art). In this respect, the following statement by the Patent Office Board of Appeals is noteworthy:

> Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual "to combine the relevant teachings of the references." ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force that would **impel** one skilled in the art to do what the patent applicant has done.

*In re Levengood*, 28 U.S.P.Q.2d 1300, 1302 (Pat. Off. Bd. App. 1993) (citations omitted; emphasis added). Significantly, the Office Action identifies no "motivating force" that would "impel" persons of ordinary skill to combine the respective teachings of the cited references in a manner that would produce the claimed inventions.

The milk product of the present invention is derived from an animal that is raised by feeding a feed material which contain omega-3 highly unsaturated fatty acids from cultured microbial organisms, thereby increasing the amount of omega-3 highly unsaturated fatty acid in the corresponding milk product.

The Hagemeister abstract discloses feeding menhaden oil to lactating cows to allegedly increase the omega-3 fatty acid content of the milk. There is no mention of any fishy taste or fishy odor of the milk thus produced. Therefore, one of ordinary skill in the

art will not be motivated to look for other sources of omega-3 fatty acids.

The Ise patent discloses feeding an omega-3 fatty acid source in conjunction with vitamin E and water which contains silicic acid, glucanase, cellulase, calcium and phosphorus. The Ise patent specifically discloses vacuum deodorized fish oil, in particular vacuum deodorized menhaden oil, as a source of omega-3 fatty acids. The Ise patent states that there is no unpleasant fishy odor in poultry products and eggs thus produced. See for example, Col. 4, lines 32-36. Therefore, one of ordinary skill in the art will have no motivation to substitute omega-3 fatty acid sources disclosed in the Ise patent with whole cell microorganisms or lipids extracted therefrom.

The Long reference discloses using extracted lipids from microorganisms as a feed additive for animals. The Long reference does not disclose or suggest using whole cell microorganisms for feeding animals of any type or using the whole cell microorganisms in the feeding of milk-producing animals. Moreover, the disclosure of Long regarding the addition of the extracted oils to animal feed includes no recognition of downstream benefits to those consuming the animal. That is, the Long reference is directed to feeding the extracted oils to an animal to benefit the animal directly and not to benefit other animals which may consume the animal that is fed the extracted oils. In addition, the Long reference does not teach

or suggest increasing the DPA, an omega-6 fatty acid. More significantly, there is no recognition, teaching or suggestion in the Long reference to change the fatty acid content of milk products by feeding the whole cell microorganism or extracted oil to milk-producing animals. Therefore, one of ordinary skill in the art will not be motivated to feed the extracted oils to a milk producing animal to increase the omega-3 fatty acid contents of the milk.

What the Office Action appears to suggest is that the claimed milk product would have been obvious because it would have been **possible** to change the source of omega-3 fatty acid as disclosed in the Hagemeister abstract or the Ise patent with the sources disclosed by the Long reference. However, none of the teachings of the Hagemeister abstract, the Ise patent and the Long reference even contemplate producing milk product using whole-cell microorganisms. The mere **possibility** that the prior art can be combined and modified does not itself provide the requisite motivation to do so. *In re Dien*, 152 U.S.P.Q. 550 (C.C.P.A. 1967) (incentive to seek improvement of existing process held to not render change made by applicant obvious, even where the change was one capable of being made from theoretical point of view). It is only with the improper use of hindsight and with the benefit of the disclosure of the present application that one can discern the desirability of the particular milk product now claimed.

Without showing a "motivating force that would **impel** one skilled in the art to do what the patent applicant has done," which is neither taught nor suggested in the prior art, the Office Action merely suggests that it would have been possible or "obvious to try." However, "obvious to try" is not the standard of 35 U.S.C. §103. *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Therefore, it is respectfully requested that the rejection under 35 U.S.C. §103 be withdrawn.

In view of the foregoing, it is respectfully submitted that the claims presently before the Examiner patentably define the invention over the applied art and are otherwise in condition for allowance. Therefore, an early Office Action to that effect is earnestly solicited. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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